

REMARKS

This Amendment is filed in response to the Office Action dated May 28, 2009. Applicants first note with appreciation the Examiner's thorough examination of the application as evidenced by the Office Action. Applicants have amended claims 1-4, 8, 21-24, and 28. Claims 9-21 have been canceled. Following these amendments, the application includes claims 1-8 and 21-28 with independent claims 1 and 21. Applicants respectfully submit that the claims are patentable. As such, Applicants respectfully request issuance of a Notice of Allowance in light of the remarks below.

I. The Claimed Invention Is Patentable Subject Matter Under § 101

In paragraph 9, the Office Action rejects claims 1-8 under 35 U.S.C. § 101 as non-patentable subject matter. The Office Action alleges that the claims are not tied to a machine or apparatus or transform a particular article. Applicants respectfully disagree with this rejection.

Claims 1-8 are tied to a particular apparatus. Independent claim 1 specifically recites a "method performed on an electronic content management system." Further, many of the claimed steps recite performing operations over an electronic network and storing data in an electronic database. Inherently the electronic content management system must contain a processor that is used to perform operations over an electronic network and store data in an electronic database, thus the claims are tied to a machine or apparatus.

Despite the fact the processor is inherent in the electronic content management system, in order to further the prosecution of the application the Applicants have amended the claims to include steps that are preformed through the use of a processor in the electronic management system. There is support in the specification for the processor because the processor is inherent in the electronic management system. In addition, the present application is a continuation-in-part of application No. 09/415,560, filed on Oct. now Pat. No. 6,643,663 ('663), which is incorporated by reference. The '663 patent includes a system for operating a content

management system with a first computing device having a processor and a storage device for storing a database (See Col. 4 ln. 1-4).

Clearly, independent claim 1 and dependent claims 2-8 are tied to a particular apparatus (i.e., a content management system, a processor, a electronic network, and an electronic database) where the steps are performed through the use of the processor.

In addition to being tied to a machine, the claimed invention also transforms an article. Specifically, the claimed invention routes comments regarding published content from the feedback message electronically via an electronic network to an electronic content management system and generates a ticket message based at least on the comments regarding published content located in the feedback message. In this regard, a ticket message is generated based on the feedback message. This is, in effect, a transformation of information from the feedback message into a ticket message.

The Office Action draws similarities between the claims of the instant application and those of *In re Abele* and argues that the claims are more akin to the claims rejected by the Court as reciting undefined and unspecified factors and testing data. The Office Action argues that the claims do not recite claims that clearly represent physical and tangible objects, such as depictions of X-ray data in a two dimensional field. Applicants, however, specifically disagree. The claimed invention determines whether a feedback message contains consumer feedback. If so, the claimed invention generates a ticket message based at least on the comments regarding published content located in said feedback message. The ticket message is new tangible item that is created based a determination that feedback message includes comments. The ticket message is not mere undefined and unspecified data. Instead, it is a new tangible item that can be routed, stored, reviewed by a user, etc. This ticket message did not exist until generated by the claimed method and computer program product.

In light of the above, the claimed invention is tied to a machine and also performs a transformation of an article and thus meets the test outlined in *In re Bilski*, No 2007-1130, Oct. 30, 2008. Applicants submit that claims 1-8 recite patentable subject matter in accordance with 35 U.S.C. § 101.

II. The Claimed Invention meets the Written Description Requirement Under § 112

In paragraphs 10 and 11, the Office Action rejects claims 1-8 and 21-28 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office action states that the term “escalation is a non-functional descriptive label for the feedback message rather than [an] activity step of escalating.” Applicants respectfully submit that the term “generating an escalation feedback message” is supported in the specification, but have amended the claims to “generating a ticket message” to further the prosecution of the application. Support for generation of a ticket message as recited in the claims is provided by at least paragraphs [0031] – [0040] of the patent application. Applicants submit that the claims 1-8 and 21-28 are in accordance with the written description requirement under 35 U.S.C § 112.

III. The Claims Are Patentable Over the Cited Prior Art

In paragraphs 12 and 13, the Office Action rejects independent claims 1, 4, 6, 7, 21, 24, 26, and 27 under 35 U.S.C. § 103 as being unpatentable over Island Data in view of Sloo (US Patent 5, 895,450).¹ Further, in paragraph 14-16 the Office Action rejected claims 2, 3, 22, 23, 5, 25, and 8 and 28 under 35 U.S.C. § 103 as obvious in light of Island Data and Sloo, in combination with respective different references. Applicants respectfully disagree with these rejections.

Regarding independent claims 1 and 21, at page 7, the Office Action states that the: “claim limitation of ‘message includes comments regarding the published content’ is being interpreted as non-functional descriptive material and which is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.”

¹ While the Office Action raises issues regarding priority date for the claims, Applicants do not address these statements herein, given that the claimed invention is clearly patentable over the cited prior art.

Similar arguments are made with respect to limitations in the dependent claims of independent claims 1 and 21, such as in claims 4 and 24, and claims 2 and 23, in which the Office Action states “specific location/individual, and the actual location/individual that receives the feedback is irrelevant since the act of receiving has no bearing on the functionality of the claims.”

Applicants respectfully disagree. However, Applicants have amended the claims to further define language in the claims to indicate that the recited processes in the claim rely on the content of the message.

Applicants further respectfully submit that the Examiner’s stance relative to the language in the claims is in error and contrary to MPEP guidelines. For example, MPEP § 2173.05(g) specifically states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself render a claim improper. ...

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step or a process to define a particular capability or purpose that is served by the recited element, ingredient or step. . . .

In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. (emphasis added) (citing *In re Barr*, 444 F.2d 588 (C.C.P.A. 1971)).

In a similar way, the amended claims of the present application use language such as “determining that said feedback message includes comments regarding published content” and “routing said comments regarding published content from said feedback message. . .” This language is functional because information from the feedback message is routed to the content

management system if the information includes comments regarding published content. Therefore, the recited process of determining if the feedback message includes comments regarding published content is functional. Thus, the recited processes are not performed in the same way if the feedback message does not have comments that relate to published content, and must be accorded weight.

In light of the above, weight must be given to recitations in claims 1 and 21 for determining that the feedback message includes comments regarding published content and that the comments are routed to the content management system if the comments are regarding published content. Failure to give weight to these recitations would be in direct contrast to MPEP § 2173.05(g). (See discussion later below regarding Office Action's use of *In re Gulack*.).

Furthermore, at least these recited limitations of claims 1 and 21 are not taught or suggested by the cited references. Nowhere does Island Data teach or suggest receiving feedback messages from customers containing comments on published content. Further, nowhere does Island Data teach or suggest routing the comments on published content to a content management system. Furthermore, nowhere does Island Data teach or suggest generating a ticket message that is at least based on the comments regarding published content. At best, Island Data discloses a technical support system where technical support questions from customers are escalated to an agent-assisted response if they cannot be answered by a simple canned solution. The claimed invention of claims 1 and 24 are somewhat different. The claimed invention is directed at receiving feedback from consumers regarding published content and providing these comments to a content management system to create a direct feedback loop between the content management system and consumers. One would be hard pressed to argue that a technical support system would teach or suggest creating such a feedback loop without use of impermissible hindsight.

On page 8, the Office Action makes the following argument regarding claim 1:

the claim limitation of “message includes comments regarding the published content” is being interpreted as non-functional descriptive material which is not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.

Applicants respectfully disagree. Independent claims 1 and 21 clearly recite determining that information from the feedback message includes comments regarding published content. This is a functional limitation of the claim that is not disclosed in the cited prior art. Island Data nowhere teaches or suggests determining that information in a message includes comments to published content. All that Island Data discloses is determining what technical question is embedded in an email. As such, despite what is argued by the Office Action, this functional limitation is not taught or suggested by the cited prior art.

It is interesting that the Office Action cites *In re Gulack* as part of the rejection. *In re Gulack* stands for the premise that an Examiner should give weight to recited claim limitations. Indeed, MPEP § 2106.01 states “USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art.” (citing *In re Gulack*). If the Examiner gives proper weight to the claims as clearly require in the MPEP at §§ 2173.05(g) and 2106.01, then it will be further determined that Island Data by itself or in combination with Sloo does not teach or suggest each and every element of independent claims 1 and 21.

Applicants thus submit that independent claims 1 and 21 and thus dependent claims 2-8 and 22-28 are patentable.

Appl. No.: 10/701,085
Amdt. dated October 28, 2009
Reply to Office Action of May 28, 2008
Atty. Dkt.: 952663-325966
Page 12 of 12

Conclusion

In view of the amended and added claims, and the remarks presented above, it is respectfully submitted that all of the present claims of the application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 13-4365.

Respectfully submitted,

/W. Kevin Ransom/

W. Kevin Ransom
Registration No. 45,031

Customer No. 24239

Moore & Van Allen PLLC
Post Office Box 13706
430 Davis Drive, Suite 500
Research Triangle Park, North Carolina 27709
Phone: (704) 331-3549
Fax: (704) 339-5918

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON October 28, 2009.